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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,992	09/29/2000	Walter W. Lee	5122	1738

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GLENN PATENT GROUP
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EXAMINER

NAJARIAN, LENA

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,992

Applicant(s)

LEE ET AL.

Examiner

Lena Najarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 and 36-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 and 36-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 10/17/05. Claims 19-25 and 36-37 remain pending.

Oath/Declaration

2. The objection to the oath/declaration is hereby withdrawn due to the amendment filed 10/17/05.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19, 21-25, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al. (4,812,628) in view of French et al. (US 6,282,658 B2).
(A) Claims 19, 21-25, and 36 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.
5. Claims 20 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al. (4,812,628) in view of French et al. (US 6,282,658 B2), and further in view of Jobber et al. ("The Prediction of Industrial Mail-survey Response Rates").

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(A) Claims 20 and 37 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 10/17/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/17/05.

(1) Applicant argues that the element of "responding" distinguishes Claim 19 from Boston. Also, the use of a predictive model (see Detailed Description of the Preferred Embodiments of Application 09/675,992) to produce the transaction score distinguishes Claim 19 from Boston. Boston's system can only generate an approval code or route the transaction to the issuer to be approved. This is a much more limited process than Claim 19's: terminating the transaction, proceeding with the request, or obtaining additional data.

(2) Applicant argues that unlike Claim 19, Boston's risk assessment is not done during the interaction with the user. Boston uses pre-determined risk assessment data pre-programmed into a transaction card (col. 5, lines 15-17). Boston's system merely reads the risk assessment information on the card and compares this information to the transaction amount. In contrast, because the transaction score is derived by evaluating the first set of transaction data to generate risk assessment, Claim 19 is distinct from Boston's use of pre-determined risk assessment information. Claim 19 describes risk assessment done during the transaction. Boston describes risk assessment as

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completed prior to the entity/user transaction. As further defined in the specification, Applicant's invention can score the user transaction "with respect to any other factor that a merchant deems useful to know." On the contrary, Boston's system is not able to use any information other than the pre-assigned risk assessment value.

(3) Applicant argues that the Examiner's citation is actually discussion of prior art relevant to Boston's patent prosecution not discussion of Boston's invention.

Furthermore, there is no mention of using a predictive model in conjunction with the transaction module (see Detailed Description of the Preferred Embodiments).

Therefore, this cited section is not teaching the transaction module element of Applicant's invention.

(4) Applicant argues that in addition to the differences between using a statistical model to produce the transaction score versus Boston's pre-assignment risk assessment value described above, Boston uses a single multiplication routine to arrive at a single number (dollar limit). In contrast, Claim 36 states "applying the score to at least one threshold" within the threshold module. "At least one threshold" teaches that the threshold module is able to apply the score to more than one threshold. Therefore, this Boston citation is inadequate to teach this threshold element of the claimed invention.

(5) Applicant argues that the Examiner claims one skilled in the art would combine Boston and French "to ensure the identity of the user and prevent fraud." Although this motivation is found in French, the Examiner's application of this motivation to solve the problem of "determining the conditions under which to request additional information" is erroneous.

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(6) Applicant argues that the applicant's invention is focused on aiding the decisioning process. French's system either authenticate or reject the user. This process does not aid decision making. Rather, French's system makes decisions according to the issuer's configuring.

(7) Applicant argues: As stated in the specification, the claimed invention "aids an entity to selectively request additional data about a user to serve the needs of the entity without causing the user to have an adverse reaction." Neither Boston nor French are focused on the conditions under which to selectively request additional information about a user. Neither are concerned with assessing transaction conditions to minimize adverse reactions. The motivation of "preventing fraud" is insufficient. One skilled in the art familiar with Boston and French would not know how to produce a decisioning system which assesses transaction conditions. Therefore, the Examiner has not explained why this condition is proper.

(8) Applicant argues that Boston and French contain no hint to suggest any aspect of the claimed invention in either of these references. Boston and French do not disclose responding to a transaction score, using a transaction module, or using a threshold module. Thus, even if these references were combined, the likelihood of success is non-existent because Boston and French are not focused on the decisioning problem described in Applicant's invention.

(A) As per the first argument, the Examiner respectfully submits that Boston discloses the element of "responding" at col. 8, lines 19-21 and 49-54. In response to applicant's

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argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "use of a predictive model") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(B) As per the second argument, the Examiner respectfully submits that at col. 5, lines 60-66 and col. 6, lines 57-64, Boston discloses that risk assessment is done during the transaction. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "can score the user transaction with respect to any other factor that a merchant deems useful to know") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) As per the third argument, the Examiner respectfully submits that the portions cited by the Examiner are from the "Detailed Description" section of Boston's patent. Boston is acknowledging that he has made an improvement to the prior art system. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "using a predictive model in conjunction with the transaction module") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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(D) In response to applicant's fourth argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "using a statistical model to produce the transaction score") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, insofar as Applicant recites "at least one," all that prior art need show is at least one threshold.

(E) As per the fifth argument, the Examiner respectfully disagrees that her motivation is erroneous. The Examiner applied the French reference for the claimed feature of "obtaining additional information." The Examiner maintains that additional information is obtained to ensure the identity of the user and prevent fraud.

(F) As per the sixth argument, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "aiding the decisioning process") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(G) In response to applicant's seventh argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "aids an entity to selectively request additional data about a user to serve the needs of the entity without causing the user to have an adverse reaction") are not

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recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(H) Applicant repeats arguments that have already been addressed above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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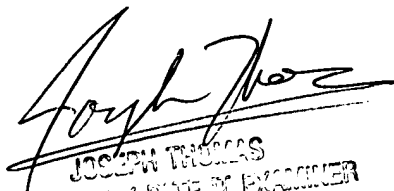
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ln

In

12-13-05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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